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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,134	12/23/1999	BRUNO GIROUARD	PM-265136	8367

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EXAMINER
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BOEHLER, ANNE MARIE M

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 11/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/472,134

Applicant(s)

GIROUARD ET AL.

Examiner

Anne Marie M Boehler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on May 22 and July 9, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-49, 55, 58-61, 64-68, 73 and 76-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-49, 55, 58-61, 64-68, 73, 76-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. The corrected or substitute drawings were received on May 22, 2002. These drawings are not approved by the examiner because they contain new matter. The windshield configuration, in particular, is not supported by the original disclosure. These changes do not make the drawings more consistent with modified Figure 4, as indicated in applicant's remarks, and they significantly alter the position of the windshield, including the position of the windshield top edge relative to the steering member (the angle formed between the windshield, seat position, and steering member, recited on pages 13 and 14), which is a claimed feature of applicant's invention and which is described in applicant's detailed disclosure.

2. Claims 1-49, 55, 57-61, 64-68, 73, and 76-92 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant fails to show an operative embodiment of the invention. The only drawings of applicant's invention are Figures 2 and 3, which show the snowmobile with a rider in the prior art position and in the position he would assume if riding on applicant's snowmobile. The main difference between the two snowmobiles (the prior art one and that of the applicants) is the position of the handlebars. However, the positioning of the handlebars in Figures 2 and 3 would not allow any significant steering of the vehicle. Therefore, applicant's invention, as disclosed, is inoperative.

The embodiment of figures 2 and 3 is the only disclosed embodiment. By showing the prior art configuration and that of applicant's invention superimposed on

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each other, applicant appears to be directing the reader to make only the changes shown and, otherwise, leave the standard snowmobile structure intact. However, following this instruction would lead a skilled artisan to construct a vehicle with a steering member (handlebar) that butts up against the windshield and is incapable of any significant steering operation.

To accomplish applicant's ultimate objective of a snowmobile with a center of gravity, seat position, foot position, and steering position which have particular relative positions, every element of the snowmobile must be taken into consideration. Applicant has not disclosed the many required elements of a working snowmobile. Basically applicant relies on an existing snowmobile configuration, with certain specific modifications. Most significant of these changes is the steering member position. However, the examiner maintains that this specific change which applicant directs the reader to make renders the vehicle inoperative, and therefore, applicant has failed to provide an enabling disclosure which would allow one of ordinary skill in the art to make and use the invention without undue or unreasonable experimentation (a complete redesign of the vehicle).

3. Claims 73, 85, 88, 89, 91, and 92 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Recitation of a "tunnel" and its relationship to other structure on the vehicle, is not supported by the original disclosure. Also, the position of the toe holds in a

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vertical plane above the rider's toe is new matter, not specifically disclosed or shown in the original drawings. The original drawings showed a vertical wall at the forward end of the footboards, which could be considered applicant's toe holds. Applicant's detailed disclosure merely referred to toe holds, without any structural detail. Applicant may not rely on the amended drawing to show this feature because that drawing change was only approved to schematically show a toe hold, not any particular location of that toe hold.

4. The amendment filed May 22, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: reference to a "tunnel" is not supported by the original disclosure and a toe hold lying in a vertical plane above the rider's toe.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Claims 1-49, 55, 57, 57, 61, 64-68, 77-84, 87, and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the claims, applicant recites a "standard rider" and/or a "standard position" of a standard rider. However, the examiner maintains that a rider, a human being, cannot be standardized. Also, even if the rider could be standardized, the position of the rider on the cycle depends on more than simply the dimensions of the rider. The stiffness of the joints, the comfortable posture, the energy level of the rider,

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and simple preferences of the rider factor into their positioning on the cycle. Therefore, applicant's recitation of the vehicle based on the position of the standard rider is believed to be indefinite because it lacks a reasonable degree of certainty with respect to the structural features it is meant to describe. ~~It forces the potential infringer to design and build his vehicle without knowing if it will infringe until tested using a standard rider.~~

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 60, 61, and 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Christensen et al. (USPN 3734219).

Christensen shows a snowmobile with a forwardmost drive axle positioned forward of the center of gravity (c.g.) and rearward of the steering member 10. It also shows two front skis, a drive track in a tunnel and a seat (d).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen in view of JA 2-274,681.

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Christensen is silent regarding the exact positioning of the footrest, although it appears to show conventional sideboards along the side of the body that end at the front cowling.

JA 2-274,681 shows a snowmobile with sideboards for a rider's feet which extend along the side of the body and end at the front cowling. The sideboards are angled at approximately 6 degrees from horizontal.

It would have been obvious to one of ordinary skill in the art to provide the Christensen snowmobile with sideboards along the sides of the body at 6 degrees from horizontal and ending at the front cowling, as taught by JA 2-274,681, in order to support the rider's feet. The upwardly extending forward end of the footboard provides a toe-hold in that it prevents the toe from sliding forward.

10. Claim 73 is rejected under 35 U.S.C. 102(b) as being anticipated by JA 2-274,681.

JA 2-274,681 shows a snowmobile with sideboards for a rider's feet, which extend along the side of the body and end at the front cowling. The sideboards are angled at approximately 6 degrees from horizontal. The forward upwardly extending wall of the cowling provides a toe hold which prevents the rider's foot from sliding forward.

11. Applicant's arguments filed May 22, 2002 and July 9, 2002 have been fully considered but they are not persuasive.

Applicant's evidence of commercial success and unexpected results will not be discussed because none of the previous rejections under 35 USC 103 is repeated herein.

Applicant points to the declaration filed July 9, 2002, paragraphs 46-48, for support that the original disclosure is enabling. The declaration indicates that one of ordinary skill in the art would not have added a windshield in a position which would destroy the ability to steer. It also points to descriptions on page 13, line 20 to page 14, line 6 for additional disclosure of the positioning of the windshield. However, these statements are not convincing. Applicant's detailed disclosure indicates that the position of the steering member is critical to the invention. It does not suggest adding a windshield that interferes with the steering member, but rather seems to teach keeping the windshield in the same position as prior art snowmobiles and moving the steering member to an extreme forward position. The portions of the specification applicant points to further reinforce that the positioning of the steering member relative to the windshield is intentional. The disclosure on pages 13 and 14 of where the windshield is positioned relative to the seating position is entirely consistent with figures 2 and 3. Therefore, the erroneous positioning of the steering member and/or the windshield appears to be not simply a drafting error, but rather a defect in applicant's entire disclosure.

Applicant indicates that another type of steering member in the position shown would be operational. However, another steering member is not shown. A vehicular steering wheel would not fit in the space shown either if its steering shaft were angled



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and positioned as disclosed, and it is not seen how an aircraft-type yoke would be adapted for a snowmobile, which has a very different drive and control system. Also, certain of applicant's claims (claim 61, for example which recites relative positions of the steering device, drive axle and center of gravity, which are all closely spaced as it is) rely on the steering member being a handlebar and extending no farther back than the position shown.

Applicant indicates that the windshield could be removed, as in Figure 4, or could move with the steering member. However, figure 4 is not described as being an embodiment of the invention with the windshield removed. Also, even if the windshield were removed, Figure 4 depicts entirely unrealistic handlebar positions. In operation a rider would not never be able to move the steering member through 90 degrees and, even if the steering member could move to that extent, skis with the type of suspension shown could turn through such an extreme angle. Therefore, figure 4 is not believed to depict an operative embodiment of applicants invention.

The declaration also points to the schematic drawing on page two of exhibit C. However, that schematic drawing, unlike the one in the present application, shows the steering member in a position which would allow significant steering. The windshield in that figure is shown with a much greater spacing between the steering member and the windshield than shown in applicant's figures 2 and 3. Therefore, applicant's arguments and exhibits are not convincing and the rejection based on 35 USC 112, first paragraph is being maintained.

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Applicant argues in his remarks, filed May 22, 2002, that, even if the examiner were correct in the determination that the windshield, as disclosed, interferes with the steering member only the claims reciting both a steering member and the windshield should be rejected on this basis. The examiner disagrees. The positioning of the steering member is absolutely critical to applicant's invention. Moving the steering position forward allows the engine to be positioned below and behind the steering member, which positions the center of gravity relatively forward and closer to the rider's center of gravity. Most of the other claimed features, particularly the recitations of the center of gravity of the snowmobile and the rider, are a result of the particular positioning of the steering member and engine. If applicant's disclosure of the steering member position is erroneous, a skilled artisan reading applicant's disclosure has very little guidance in making the claimed invention. In fact an artisan would essentially have to start from scratch in constructing an operative embodiment. The examiner maintains that that would require undue experimentation and, therefore, applicant's overall disclosure is not enabling of the claimed subject matter.

Applicant indicates that the windshield could be removed so that it would not interfere with the steering member. However, the windshield is not disclosed as an optional feature. Rather, it is disclosed as a significant part of applicant's invention and continues to be claimed. Also, the only figures that show any significant portion of the invention are Figures 2 and 3, and the windshield is part of the embodiment of those figures. Therefore, the rejection under 35 USC 112, first paragraph is being maintained.

Applicant traverses the rejection based on 35 USC 112, second paragraph, in the remarks filed May 22, 2002. Applicant argues that it is unreasonable for the examiner to preclude claim language which relies on the definition of a rider and how/where that rider would sit on applicant's vehicle. The examiner disagrees. Applicant has provided examples of claim language relating to a rider's dimensions which were found to be permissible, where the rider's dimensions were specified. However, even if it is permissible to relate claim structure to a single simple dimension of a user, like his height or the length of his thigh (where that dimension is provided in the disclosure) that is not what applicant is doing in the present case. Applicant's claims are not so simple or straightforward. A potential infringer, to determine infringement of most of applicant's claims, would have to design and build a snowmobile and then place a standard sized person on it, in the "standard position", as best can be made out from applicant's disclosure. The examiner believes this would involve undue experimentation and uncertainty for the potential infringer. Applicant states that the scope of each claim can be determined with an incredible amount of detail with respect to the standard rider. However, the examiner does not believe the features of applicant's snowmobile can be extrapolated from applicant's disclosure and drawings (particularly in view of the problems with the drawings, indicated above) with any degree of certainty. The details are not of the vehicle but rather are based on a theoretical position that a particular rider would assume. Therefore, the rejection, based on 35 USC 112, second paragraph, is being maintained.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie M Boehler whose telephone number is 703-308-0422. The examiner can normally be reached on 7:30-5:00, Monday-Thursday, and alternate Fridays,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9325 for regular communications and 703-872-09327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*Amb 11/4/02*

Anne Marie M Boehler  
Primary Examiner  
Art Unit 3611

Amb  
November 4, 2002